PRE-APPEAL BRIEF REQUEST FOR REVIEW (filed with the Notice of Appeal)	Docket Number 050704/306103
Application Number: 10/820,209	Filed: April 7, 2004
First Named Inventor: Richard Lunak	
Art Unit: 2876	Examiner: ST. CYR, DANIEL

Applicants request review of the non-final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

Respectfully submitted,

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Date April 14, 2009

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Attachment
Reasons for Requesting Pre-Appeal Brief Request for Review

Applicants are requesting a Pre-Appeal Brief Request for Review on the basis that the Examiner has failed to show that the cited art teaches or suggests each and every element as set forth in the claims.

I. Introduction

Claims 15-30 are pending in the application. Claims 15-30 stand rejected under a non-final Office Action dated January 14, 2009 ("the current Office Action"). Specifically, the Office Action rejects Claims 15-30 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,112,502 to Frederick et al. ("the Frederick reference") in view of U.S. Patent No. 5,797,515 to Liff et al. ("the Liff reference").

II. Rejections of the Claims

Applicants submit that the rejections of Claims 15-30 should be reversed because (A) the current Office Action is improper because it fails to clearly assert that the cited references, either individually or in combination, teach or suggest each and every element of the current claims, and (B) notwithstanding, the combination of the cited references fails to teach or suggest each and every element of the current claims.

A. The rejections under 35 U.S.C. §103(a) are improper

Applicants respectfully submit that the current rejections of independent Claims 15 and 23 are improper since in order to render a claim obvious, the cited references must teach every element of the claim. However, the current Office Action fails to clearly assert that the combination of the Frederick and Liff references teaches each and every element of independent Claims 15 and 23. Specifically, the current Office Action refers to elements of Claims 15 and 23 that had been previously amended out of the claim language. For example, pages 2-3 of the current Office Action refer to "inputting information into a handheld device ..." and "inputting a current quantity of the items to be restocked to the handheld device...." As of the Preliminary Amendment of December 7, 2007, these portions of Claim 15 were amended to recite "receiving information input into a handheld device ..." and

"receiving a quantity of said item requested at a decentralized storage location into the handheld device...." Claim 23 was amended to recite "receiving information input into a handheld device ..." and "receiving a quantity of each of the items requested at a decentralized storage location into the handheld device...." The rejection portion of the current Office Action appears to repeat, verbatim, the rejections issued in the previous rejection of July 16, 2007. Although some limited portions of the current claim language appear to be discussed in the "Response to Arguments" section of the Office Action, Applicants note that the Examiner does not address each and every element of the current language of independent Claims 15 and 23.

Accordingly, given that the Office Action fails to clearly assert that the combination of the Frederick and Liff references discloses the recited features and that no rationale or evidence showing inherency of these features has been set forth in the Office Action, the rejection of independent Claims 15 and 23 based on the combination of the Frederick and Liff references is improper. Since the remaining claims depend from either independent Claim 15 or 23, Applicants further submit that the rejections of Claims 16-22 and 24-30 are also improper.

B. Claims 15-30 are patentable over the cited references

Notwithstanding the impropriety of the current rejections, Applicants further submit that the combination of the cited references fails to teach or suggest the features of independent Claims 15 and 23. In this regard, independent Claim 15 recites, in part, receiving information input into a handheld device from an indicium on an open shelving system, said information identifying an item stocked on said open shelving system; receiving a quantity of said item requested at a decentralized storage location into the handheld device; receiving into a workstation a current quantity of said item stored in a centralized storage location; transferring the information and the quantity of said item requested from the handheld device; automatically comparing, in a computing device, the current quantity to a par level for said item; and queuing in the computing device a restocking package to be processed for the decentralized storage location in response to the information and the quantity of said item requested. (Emphasis added). Independent Claim 23 recites, in part, receiving information input into a handheld device from said indicium associated with each bin identifying an item stored therein; receiving a quantity of each of the items requested at a decentralized storage location into the handheld device corresponding to the input information; receiving into a workstation a current quantity of the items stored in a centralized storage location; transferring the information and the quantity of each of

the items requested from the handheld device; automatically comparing, in a computing device, the current quantity of each of the items to a par level for each item; and queuing in the computing device a restocking package to be processed for the decentralized storage location in response to the information and the quantity of each of the items requested. (Emphasis added). Applicants submit that the combination of Frederick and Liff references does not teach or suggest the elements of independent Claims 15 and 23. Particular examples of the deficiencies of the cited references are provided below with the deficiencies relative to independent Claim 15 being provided in line and the deficiencies associated with independent Claim 23 being provided parenthetically.

The Frederick reference discloses a method for monitoring, dispensing, and restocking medical items from a plurality of storage locations. Each storage location of the Frederick reference is marked with a desired level or quantity for the item contained therein. Each storage location is further marked with one or more scannable indicia (e.g., bar code labels) corresponding to a "quantity condition." For example, one scannable indicium may correspond to a "below par level" condition, while another indicium may correspond to an "out of stock" condition. A user of the system determines whether an item requires restocking, such as by determining if the current quantity of the item is below the indicated par level or if the item is out of stock. The user then scans the appropriate indicium, corresponding to the determined quantity condition, using a handheld device. This causes the transmission of a message indicating that the particular storage location requires restocking. A data store may also include data representative of the number of units remaining in each storage location.

Among other things, however, the Frederick reference does not teach or suggest receiving into a handheld device a quantity of the item requested at a decentralized storage location (or receiving into a handheld device a quantity of each of the items requested at a decentralized storage location) and receiving into a workstation a current quantity of the item (or items) stored in a centralized storage location. Nor does the Frederick reference teach or suggest queuing in the computing device a restocking package to be processed for a decentralized storage location in response to the information and the quantity of the item requested (or queuing in the computing device a restocking package to be processed for the decentralized storage location in response to the information and the quantity of each of the items requested).

The Liff reference teaches comparing a package bar code label with a column bar code label before loading the package into a column, and recording the number of bottles in each column. This comparison may take place visually as the reference does not explicitly teach or suggest scanning

either the package bar code label or the column bar code label to perform the comparison. *See* col. 6, lines 45-67. The Liff reference then teaches scanning the package bar code label as a package is dispensed. *See* col. 6, lines 51-54.

Among other things, however, the Liff reference does not teach or suggest receiving into a handheld device a quantity of the item requested at a decentralized storage location (or receiving into a handheld device a quantity of each of the items requested at a decentralized storage location) and receiving into a workstation a current quantity of the item (or items) stored in a centralized storage location. Nor does the Liff reference teach or suggest queuing in the computing device a restocking package to be processed for a decentralized storage location in response to the information and the quantity of the item requested (or queuing in the computing device a restocking package to be processed for the decentralized storage location in response to the information and the quantity of each of the items requested).

Furthermore, Applicants note that the current application is related to U.S. Application No. 10/820,213 as both applications are divisional applications from the same parent application. The claims of Application No. 10/820,213 are directed to systems for monitoring and restocking medical items from a plurality of storage locations, whereas the claims of the current application are directed to similar methods. As such, sole independent Claim 1 of Application No. 10/820,213 includes system claim recitations that are similar to the method claim recitations of independent Claims 15 and 23 of the current application. Both the Frederick reference and the Liff reference have been cited by the Examiner against Application No. 10/820,213, and Applicants note that a Notice of Allowance was issued for Application No. 10/820,213 on March 30, 2009.

In view of the remarks presented above, Applicants respectfully submit that independent Claims 15 and 23, as well as the claims that depend therefrom, are patentable over the cited references, alone or in combination. As such, all of the present claims of the present application are in condition for immediate allowance.

III. Conclusion

In the present situation, not only does the combination of the Frederick and Liff references fail to teach or suggest the claimed features described above, but the Office Action fails to clearly assert that these elements are disclosed by the combination of the Frederick and Liff references.

As such, Applicants have seasonably challenged whether the cited references teach or suggest at least one of the features for which no explanation is given as to how the cited references teach or suggest the corresponding feature. Applicants again seasonably challenge the assertion that these features are disclosed in the combination of the Frederick and Liff references, and submit that the rejection of Claims 15 and 23 should be reversed. Because Claims 16-22 and 24-30 include each of the claim recitations of independent Claims 15 and 23, respectively, and for at least the same reasons as above, Applicants also submit that the current rejections of Claims 16-22 and 24-30 should be reversed.